

## **REMARKS**

Applicant respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed August 14, 2007. Applicant respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 21 – 40 are pending. In particular, Applicant amends claims 21, 23 – 25, 28, 30 – 32, 35, and 37 – 39. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Examiner Interview**

Applicant first wishes to express sincere appreciation for the time that Examiner Filipczyk spent with Applicant's Attorney, Anthony Bonner, during a telephone discussion on October 10, 2007 regarding the outstanding Office Action. During that conversation, Examiner Filipczyk and Mr. Bonner discussed potential arguments and amendments with regard to claim 21, in view of the 35 U.S.C. §101 and §112 rejections. The general thrust of the potential principal arguments included a discussion of at least one embodiment of the present application disclosing the contested language and being allowable in view of the current Office Action. Thus, Applicant respectfully requests that Examiner Filipczyk carefully consider this response and the amendments.

## **II. Rejections Under 35 U.S.C. §101**

The Office Action indicates that claims 21 – 40 stand rejected under 35 U.S.C. §101 as claiming allegedly that the invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection for at least the reason that claims 21 – 40 include elements associated with “providing a combined score to a user.” Applicant respectfully submits that claims 21 – 40 fulfill the requirements of 35 U.S.C. §101 for at least the reason that providing data to a user is a tangible result. For at least this reason Applicant respectfully requests withdrawal of this rejection.

## **III. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claims 23 – 25, 30 – 32, and 37 – 39 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to fulfill the enablement requirement. Applicant respectfully traverses this rejection. More specifically, Applicant submits that, as illustrated on page 14, paragraph [0053], among other places, the written description describes the subject matter of claims 23 – 25, 30 – 32, and 37 – 39 to enable one of ordinary skill in the art to make and use that which is recited in the claims. More specifically, on page 14, paragraph [0053], the present application states “since no occurrences resulted from the search of the social security number, the risk of identity theft is relatively low. Also, since the name appears in combination with the telephone number as well as the street address, there is a privacy risk... Due to the enormous number of occurrences for the email address... the report shows that ‘Bob Smith’ has a very high risk of receiving spam.” As illustrated from this passage, the enablement requirement for claims 23 – 25, 30 – 32, and 37 – 39 is met. For at least this reason, these claims are allowable.

The Office Action also indicates that claims 23 – 25, 30 – 32, and 37 – 39 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly

point out and distinctly claim the subject matter which Applicant regard as the invention. In response to the Office Action's request, Applicant amends claims 23 – 25, 30 – 32, and 37 – 39. Applicant submits that these amendments comply with the Office Action's request and that no new matter has been added.

#### IV. Rejections Under 35 U.S.C. §103

##### A. Claim 21 is Allowable Over Woods in view of Clark

The Office Action indicates that claim 21 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 ("*Woods*") in view of U.S. Publication Number 2004/0153663 Clark et al., ("*Clark*"). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 21. More specifically, claim 21 recites:

A computer-readable medium comprising:

computer-readable code adapted to instruct a programmable device to search for a first piece of sensitive information, ***the first piece of sensitive information including personal information regarding at least one user,***

computer-readable code adapted to instruct a programmable device to search for a second piece of sensitive information, ***the second piece of sensitive information including personal information regarding the at least one user,***

computer-readable code adapted to instruct a programmable device to obtain a result of the search for the first piece of sensitive information;

computer-readable code adapted to instruct a programmable device to obtain a result of the search for the second piece of sensitive information;

computer-readable code adapted to instruct a programmable device to assign a first score, ***the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;***

computer-readable code adapted to instruct a programmable device to assign a second score, ***the second score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;***

computer-readable code adapted to instruct a programmable device to combine the first score and the second score;

computer-readable code adapted to instruct a programmable device to provide the combined score to a user; and

computer-readable code adapted to instruct a programmable device to determine, from the combined score, a risk for at least one identity-related vulnerability.

**(emphasis added)**

Applicant respectfully submits that claim 21, as amended, is allowable over the cited art for at least the reason that the combination of *Woods* and *Clark* fails to disclose, teach, or suggest a “computer-readable medium comprising... computer-readable code adapted to instruct a programmable device to search for a first piece of sensitive information, ***the first piece of sensitive information including personal information regarding at least one user***... computer-readable code adapted to instruct a programmable device to search for a second piece of sensitive information, ***the second piece of sensitive information including personal information regarding the at least one user***... computer-readable code adapted to instruct a programmable device to assign a first score, ***the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data***... [and] computer-readable code adapted to instruct a programmable device to assign a second score, ***the second score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data***” as recited in claim 21, as amended.

More specifically, *Woods* discloses a “[u]ser application 120, for example, a web browser... [that] receives user queries, including a term combination of terms, and a set of parameters” (column 5, line 44). However, *Woods* fails to disclose searching for sensitive information that includes personal information regarding at least one user, as described in claim 21. For at least the reason that receiving user queries is different than the recited elements, claim 21, as amended, is allowable over *Woods*.

Additionally, *Woods* fails to disclose a first score and a second score being determined from the number of occurrences of the first piece of sensitive data and the second piece of sensitive data, respectively. More specifically, *Woods* discloses a “[q]uery

dispatcher/aggregator 130 [that] merges hits and scores from the various index managers” (column 9, line 28). Applicant respectfully submits that this is different than claim 21, as amended, for at least the reason that merging hits and scores is different than determining scores based the number of occurrences of sensitive data. Further, *Woods* fails to disclose anything related to determining a score based on the number of occurrences in a piece of sensitive data, as recited in claim 21, as amended. For at least this reason, claim 21, as amended, is allowable.

Further, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* discloses making “as assessment of relative risk of identity theft fraud” (page 2, paragraph [0028]). However, *Clark* fails to disclose searching for sensitive information, where the sensitive information includes personal information regarding at least one user. *Clark* also fails to disclose assigning a score, where the score is determined based on the number of occurrences of sensitive data, as revealed in the search. For at least the reason that *Clark* fails to disclose that which *Woods* neglects, claim 21, as amended, is allowable.

#### **B. Claim 28 is Allowable Over *Woods* in view of *Clark***

The Office Action indicates that claim 28 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 (“*Woods*”) in view of U.S. Publication Number 2004/0153663 Clark et al., (“*Clark*”). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 28. More specifically, claim 28 recites:

A method comprising:  
searching for a first piece of sensitive information, ***the first piece of sensitive information including personal information regarding at least one user;***  
searching for a second piece of sensitive information, ***the second piece of sensitive information including personal information regarding the at least one user;***  
obtaining a result of the search for the first piece of sensitive information;

obtaining a result of the search for the second piece of sensitive information;

assigning a first score, ***the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;***

assigning a second score, ***the second score being determined from the number of occurrences of the second piece of sensitive data, as revealed in the search for the second piece of sensitive data;***

combining the first score and the second score;

providing the combined score to a user; and

determining, from the combined score, a risk for at least one identity-related vulnerability.

**(emphasis added)**

Applicant respectfully submits that claim 28, as amended, is allowable over the cited art for at least the reason that the combination of *Woods* and *Clark* fails to disclose, teach, or suggest a “method comprising... searching for a first piece of sensitive information, ***the first piece of sensitive information including personal information regarding at least one user...*** searching for a second piece of sensitive information, ***the second piece of sensitive information including personal information regarding the at least one user...*** assigning a first score, ***the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data...*** [and] assigning a second score, ***the second score being determined from the number of occurrences of the second piece of sensitive data, as revealed in the search for the second piece of sensitive data***” as recited in claim 28, as amended.

More specifically, *Woods* discloses a “[u]ser application 120, for example, a web browser... [that] receives user queries, including a term combination of terms, and a set of parameters” (column 5, line 44). However, *Woods* fails to disclose searching for sensitive information that includes personal information regarding at least one user, as described in claim 28. For at least the reason that receiving user queries is different than the recited elements, claim 28, as amended, is allowable over *Woods*.

Additionally, *Woods* fails to disclose a first score and a second score being determined from the number of occurrences of the first piece of sensitive data and the second piece of sensitive data, respectively. More specifically, *Woods* discloses a “[q]uery dispatcher/aggregator 130 [that] merges hits and scores from the various index managers” (column 9, line 28). Applicant respectfully submits that this is different than claim 28, as amended, for at least the reason that merging hits and scores is different than determining scores based the number of occurrences of sensitive data. Further, *Woods* fails to disclose anything related to determining a score based on the number of occurrences in a piece of sensitive data, as recited in claim 28, as amended. For at least this reason, claim 28, as amended, is allowable.

Further, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* discloses making “an assessment of relative risk of identity theft fraud” (page 2, paragraph [0028]). However, *Clark* fails to disclose searching for sensitive information, where the sensitive information includes personal information regarding at least one user. *Clark* also fails to disclose assigning a score, where the score is determined based on the number of occurrences of sensitive data, as revealed in the search. For at least the reason that *Clark* fails to disclose that which *Woods* neglects, claim 28, as amended, is allowable.

**C. Claim 35 is Allowable Over *Woods* in view of *Clark***

The Office Action indicates that claim 35 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 (“*Woods*”) in view of U.S. Publication Number 2004/0153663 Clark et al., (“*Clark*”). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claim 35. More specifically, claim 35 recites:

A system comprising:  
a first searching component configured to search for a first piece  
of sensitive information, ***the first piece of sensitive information***

**including personal information regarding at least one user,**

a second searching component configured to search for a second piece of sensitive information, **the second piece of sensitive information including personal information regarding the at least one user,**

a first obtaining component configured to obtain a result of the search for the first piece of sensitive information;

a second obtaining component configured to obtain a result of the search for the second piece of sensitive information;

a first assigning component configured to assign a first score, **the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data;**

a second assigning component configured to assign a score, **the second score being determined from the number of occurrences of the second piece of sensitive data, as revealed in the search for the second piece of sensitive data;**

a combining component configured to combine the first score and the second score;

a first providing component configured to provide the combined score to a user; and

a determining component configured to determine, from the combined score, a risk for at least one identity-related vulnerability.

**(emphasis added)**

Applicant respectfully submits that claim 35, as amended, is allowable over the cited art for at least the reason that the combination of *Woods* and *Clark* fails to disclose, teach, or suggest a “system comprising... a first searching component configured to search for a first piece of sensitive information, **the first piece of sensitive information including personal information regarding at least one user...** a second searching component configured to search for a second piece of sensitive information, **the second piece of sensitive information including personal information regarding the at least one user...** a first assigning component configured to assign a first score, **the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data...** [and] a second assigning component configured to assign a score, **the second score being determined from the number of occurrences of the second piece of sensitive data, as revealed in the search for the second piece of sensitive data**” as recited in claim 35, as amended.



More specifically, *Woods* discloses a “[u]ser application 120, for example, a web browser... [that] receives user queries, including a term combination of terms, and a set of parameters” (column 5, line 44). However, *Woods* fails to disclose searching for sensitive information that includes personal information regarding at least one user, as described in claim 35. For at least the reason that receiving user queries is different than the recited elements, claim 35, as amended, is allowable over *Woods*.

Additionally, *Woods* fails to disclose a first score and a second score being determined from the number of occurrences of the first piece of sensitive data and the second piece of sensitive data, respectively. More specifically, *Woods* discloses a “[q]uery dispatcher/aggregator 130 [that] merges hits and scores from the various index managers” (column 9, line 28). Applicant respectfully submits that this is different than claim 35, as amended, for at least the reason that merging hits and scores is different than determining scores based the number of occurrences of sensitive data. Further, *Woods* fails to disclose anything related to determining a score based on the number of occurrences in a piece of sensitive data, as recited in claim 35, as amended. For at least this reason, claim 35, as amended, is allowable.

Further, *Clark* fails to overcome the deficiencies of *Woods*. More specifically, *Clark* discloses making “as assessment of relative risk of identity theft fraud” (page 2, paragraph [0028]). However, *Clark* fails to disclose searching for sensitive information, where the sensitive information includes personal information regarding at least one user. *Clark* also fails to disclose assigning a score, where the score is determined based on the number of occurrences of sensitive data, as revealed in the search. For at least the reason that *Clark* fails to disclose that which *Woods* neglects, claim 35, as amended, is allowable.

**D. Claims 22 – 27, 29 – 34, and 36 – 40 are Allowable Over *Woods* in view of *Clark***

The Office Action indicates that claims 22 – 27, 29 – 34, and 36 – 40 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,101,491 (“*Woods*”) in view of U.S. Publication Number 2004/0153663 Clark et al., (“*Clark*”). Applicant respectfully traverses this rejection for at least the reason that *Woods* in view of *Clark* fails to disclose, teach, or suggest all of the elements of claims 22 – 27, 29 – 34, and 36 – 40. More specifically, dependent claims 22 – 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claims 29 – 34 are believed to be allowable for at least the reason that they depend from allowable independent claim 28. Further, dependent claims 36 – 40 are believed to be allowable for at least the reason that they depend from allowable independent claim 35. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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